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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,018	11/16/2000	Harry Thomas Kloor	18822-11	5553

7590

07/29/2004

Oppenheimer Wolff & Donnelly LLP
2029 Century Park East
38th Floor
Los Angeles, CA 90067

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,018

Applicant(s)

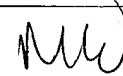
KLOOR, HARRY THOMAS

Examiner

James S McClellan

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 and 51-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/25/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Applicant's election on April 30, 2004 with traverse of **A1** from Group A, **B1** from group B, and **C1** from Group C is acknowledged.

2. The traversal is on the ground(s) that Groups A and B are not distinct.

Additionally, Applicant traverses the species restriction of Group C because Applicant alleges that the Examiner has not shown an appropriate explanation for such an election. Applicant's arguments for Groups A and B are persuasive and the restrictions for Groups A and B are withdrawn. Regarding Group C, Applicant points to 37 CFR 1.141 (a) to support Applicant's position that a reasonable number of species may be claimed in one application. This is not found persuasive because the Examiner is not requiring that each of the claims directed to the non-elected species be canceled. The Examiner is merely requesting Applicant to select one species to be examined and if a generic claim is allowed, all non-elected species will be allowed as dependent claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 31**, it is unclear what applicant means by the term a "rapid communication address". As set forth below, Brisebois disclose contact information including a website address and IP address. Clarification is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 6, 17, 20, 21, 27, 29, 31, 35-38, 42, 45-46, 51-54, 56, and 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, Applicant failed to recite the use of technology in the cited claims. The methods as claimed in the cited claims can be carried out manually without

Art Unit: 3627

applying, involving, using, or advancing the technological arts. Clearly, Applicant's invention is conducted using a computer system. The Examiner recommends adding limitations to the body of the claims rejected under 35 U.S.C. § 101 that clarify that the method is conducting using technology as opposed to a manual or mental process. As an example, adding the limitations of claim 2 to claim 1 would overcome the 35 U.S.C. § 101 rejection of claim 1 because communicating over the Internet is clearly applying technology.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 12, 16, 18-27, 29-31, 33, and 56-62 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,330,550 (hereinafter "Brisebois").

Regarding **claim 1**, Brisebois discloses a method for authorizing a transaction comprising: sending, receiving, and storing contact information (stored in profile DB 140, see column 3, lines 14-40); entering into a transaction (see step 430 in Figure 4); sending the authorization request (see step 450 in Figure 4); receiving the authorization request and sending a response (see column 3, line 49 - column 4, line 3); receiving the

Art Unit: 3627

response and completing the transaction (see column 3, lines 40-54); **[claims 2-4, and 12]** over the Internet (see 270 in Figure 2) using email, a telephone line (see column 3, lines 49-54), or a wireless system/personal communication device (see Pager 250 in Figure 2); **[claims 6-7]** credit card purchase at an online store (see column 3, lines 28-40); **[claims 8-10]** a soft-card software for authorization (see column 3, line 40 - column 4, line 3); and **[claim 16]** information is entered into a website (see column 3, lines 4-14).

Regarding **claim 18**, Brisebois discloses a method for allowing only an owner to approve of a transaction comprising: acquiring contact information; receiving a request to authorize; using the contact information to send the request; and sending approval (see detailed analysis set forth for claim 1); **[claim 19]** contact information is an Internet address of the owner (see column 3, lines 64-66); and **[claims 20-27, 30, and 31]** as set forth above for claims dependent from claim.

Regarding **claim 56**, Brisebois disclose a method for parties to communicate a transaction as set forth above in detail for claim 1; **[claim 57]** the contact information is an IP address (see column 4 lines 55-63); and **[claim 58]** an authorization agent (see profile server 110).

Regarding **claim 59**, Brisebois discloses a system for authorizing a transaction, comprising a server (110); a card registered with the server (see column 3, lines 28-40); and **[claims 60-62]** a credit card transaction over the Internet (see column 3, lines 28-40).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3627

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11, 17, 28, 36, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view U.S. Patent No. 6,055,505 (hereinafter "Elston").

Brisebois discloses all the limitations as set forth above, but fails to disclose requiring a password/PIN.

Elston discloses a password/PIN (see column 3, line 49 - column 4, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois with a password/PIN as taught by Elston, because passwords/PINs provided added security to protect confidential information.

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Official Notice.

Brisebois discloses all the limitations as set forth above, but fails to disclose the use of a cellular phone or a PDA as a personal communication device.

The Examiner takes Official Notice that like pagers, cell phones and PDA's, are old and well known personal communication devices.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois with cell phone and PDA communication, because cell phone and PDA's allow two way communication.

12. Claims 15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of U.S. Patent No. 5,760,771 (hereinafter "Blonder").

Brisebois discloses all the limitations as set forth above, but fails to disclose the use of an e-signature for an agreement.

Art Unit: 3627

Blonder teaches the use of e-signatures (see column 9, lines 24-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois with e-signatures as taught by Blonder, because e-signatures add an additional level of security from fraud.

13. Claim 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view U.S. Patent No. 6,330,672 (hereinafter "Shur").

Brisebois discloses all the limitations as set forth above, but fails to disclose the use of a digital watermark.

Shur teaches the use of digital watermarks (see column 2, lines 20-30 and column 4, lines 56-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois with digital watermarks as taught by Shur, because digital watermarks add an additional level of security from fraud.

14. Claims 35, 42-46, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of U.S. Patent No. 6,442,526 (hereinafter "Vance").

Brisebois discloses all the limitations as set forth above, but fails to disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

15. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Elston as applied to claim 36 above, and further in view of Official Notice.

Brisebois discloses all the limitations as set forth above, but fails to disclose that contact information is only established for a predetermined amount of time.

The Examiner takes Official Notice that is old and well known in the art to change PINs or passwords after a predetermined period of time.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois/Elston with changing PINs/passwords, because modifying PINs provides an additional level of security from fraud.

16. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Elston and Vance.

Brisebois in combination with Elston disclose all the limitations as set forth above, but fail to disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois/Elston with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

17. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Vance as applied to claim 42 above, and further in view of Official Notice.

Brisebois in combination with Vance disclose all the limitations as set forth above, but fail to disclose an electronic wallet.

The Examiner takes Official Notice that using an electronic wallet for online purchases is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois/Vance with an electronic wallet as is well known in the art, because electronic wallets store important personal and account information in a secure and easy to use format.

18. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Vance as applied to claim 42 above, and further in view of U.S. Patent No. 6,390,362 (hereinafter "Martin").

Brisebois in combination with Vance disclose all the limitations as set forth above, but fail to disclose a check with a bar code.

Martin teaches the use of a check with a barcode (see column 4, lines 5-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brisebois/Vance with check payment with a barcode as taught by Martin, because utilizing a check with a barcode adds an additional level of security to reduce fraud.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Art Unit: 3627

Talati is cited of interest for disclosing a method and apparatus for e-commerce validation.

Gifford is cited of interest for disclosing a authentication payment system.

Goldsmith is cited of interest for disclosing a system for electronic notification of account activity.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

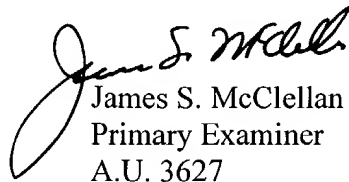
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm; July 25, 2004